

**REMARKS/ARGUMENTS**

After the foregoing Amendment, claims 7, 9-15, and 17-19 are pending in this application. Claims 2-6 and 16 have been cancelled for being directed to a non-elected invention, without prejudice to filing a divisional application directed thereto. Claims 1 and 8 have been cancelled. Claim 7 has been amended to include all of the subject matter of claim 8. Claims 14 and 18 have been amended to overcome a rejection under 35 U.S.C. § 112, second paragraph. No new matter has been added.

**Claim Rejection – 35 U.S.C. § 112, Second Paragraph**

The Examiner has rejected claims 9, 14, and 18 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants respectfully traverse this rejection in view of the foregoing amendment.

The Examiner rejected claim 9 because antecedent basis for elements in claim 9 were in claim 8, not in claim 7 from which claim 9 depends. Because Applicants amended claim 7 to include the subject matter of claim 8, there now exists antecedent basis in amended claim 7 for the elements of claim 9. Since claim 7 has been amended to include the subject matter of claim 8, it is respectfully requested that the Examiner withdraw rejection of claim 9.

The Examiner rejected claim 14 because he asserts that it is indefinite because it appears to require the welded portion to be on the ends of the package while simultaneously reciting that they are on the sides of the package. Applicants have amended claim 14 to better clarify that the welded portion attaches the end portions of the sheet.

The Examiner rejected claim 18 as being indefinite, asserting that it is not clear how the single pore can be provided at each end, as claimed. Applicants have amended claim 18 to require at least one pore at each end portion.

It is respectfully submitted that claims 9, 14, and 18, as amended, are in full compliance with 35 U.S.C. § 112, second paragraph. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

**Claim Rejections – 35 U.S.C. § 102(b)**

The Examiner has rejected claim 1 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,333,570 (Heider). Applicants have canceled claim 1, thereby rendering the Examiner's rejection of claim 1 moot.

The Examiner has rejected claims 7, 10, 11, 14, and 15 under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 4,166,532 (Tsuchida et al.). Because claim 7 has been rewritten to include all of the limitations of claim 8, which the Examiner has indicated would be allowable, the Examiner's rejection of claim 7 is rendered moot. Additionally, because claims 10, 11, 14, and 15 depend from claim 7, the Examiner's rejection of those claims is similarly rendered moot.

It is respectfully submitted that claims 7, 10, 11, 14, and 15, as amended, are in condition for allowance. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

**Claim Rejections – 35 U.S.C. § 103(a)**

The Examiner has rejected claims 12 and 13 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,166,532 (Tsuchida et al.) in view of U.S. Patent No. 4,696,402 (Harmon et al.). Because claims 12 and 13 depend from amended claim 7, which the Examiner has indicated would be allowable, the Examiner's rejection of claims 12 and 13 is rendered moot. Therefore, it respectfully submitted that claims 12 and 13 are in condition for allowance. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

The Examiner has rejected claims 17-19 under 35 U.S.C. § 103(a) as being unpatentable over Tsuchida et al. in view of U.S. Patent No. 4,971,197 (Worley) and U.S. Patent No. 6,105,776 (Meilhon). Applicants respectfully traverse this rejection.

The Examiner states that Tsuchida et al. discloses most of the elements of the claims. The Examiner admits that Tsuchida et al. lacks first and second heat-shrinkable films and at least one pore. The Examiner contends that Worley shows that it is conventional to construct heat shrunk battery packages from first and second heat shrinkable films. The Examiner further contends that Meilhon shows that providing pores at sides and ends of a heat shrunk package to facilitate opening the package is conventional. The Examiner asserts that it would have been obvious in view of Worley and Meilhon to provide the package of Tsuchida et al. with the missing elements respectively, for the purpose of improving package performance, such as by

facilitating the carrying of additional batteries and making the package easier to open.

Applicants respectfully traverse this rejection.

Tsuchida et al. does not disclose each and every element of the present invention and is an entirely different structure from the present invention. Tsuchida et al. discloses a package for batteries comprising a header board 1 and a heat-shrunk thermoplastic film 2. The header board 1 is partially engaged within the film 2. Tsuchida et al. indicates that it would be preferable to have a series of small perforations 2a through the film 2 so that the film 2 can be torn easily along the perforations in order to remove the batteries from the package. But, Tsuchida et al. does not disclose a second heat-shrinkable film. Consequently, Tsuchida et al. does not disclose a composite battery package having a first heat-shrinkable film and a second heat-shrinkable film with at least one pore formed in the second heat-shrinkable film corresponding to a boundary between unit packages. Accordingly, there is no objective teaching in Tsuchida et al. that would enable one of ordinary skill in the art to modify the package for batteries in a manner that would render the present invention obvious under 35 U.S.C. § 103(a).

Worley discloses a battery package 10 having a plurality of individual sets 12 of dry cell batteries 14. The sets 12 are individually packaged within a sleeve 20 having a tear strip 30 for opening of the set 12. Four sets 12 are then arranged to form a generally rectangular grouping having a pair of rows 16, 18 of batteries 14, which is then inserted into an outer sleeve 40 that is heat-shrunk around the sets 12. Instead of a pore, a tear strip 46 is included in the sleeve 40 to allow for easy opening of the sleeve 40. Consequently, Worley does not disclose a composite battery package having first and second heat-shrinkable films and at least one pore formed in the second heat-shrinkable film. Accordingly, there is no objective teaching in Worley that would enable one of ordinary skill in the art to modify the Tsuchida et al. battery package in a manner that would render the present invention obvious under 35 U.S.C. § 103(a).

Meilhon discloses a pack 1 of articles 2 such as cans of food, packaged using a plastic material film 3. The articles 2 are disposed side-by-side in two horizontal layers separated by a board 4. The film 3 is heat-shrunk to tighten around the articles 2. Around four sides of pack 1 is a band 6 having lines of perforations 7, 9, 10. To open the pack 1, a user presses a finger along the band 6 to rupture the film 3 at a point along the line of perforations 7 to form a tongue J. The tongue J is then pulled in a direction transverse to the band 6 to open the pack 1. However, Meilhon does not disclose a second heat-shrinkable film. Consequently, Meilhon does

not disclose a composite battery package having first and second heat-shrinkable films with at least one pore formed in the second heat shrinkable film.

It is well settled that when making a rejection under 35 U.S.C. § 103(a), the Examiner has the burden of establishing a *prima facie* case of obviousness. The Examiner can satisfy this burden only by showing an objective teaching in the prior art, or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the teachings of the references in the manner suggested by the Examiner. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion or incentive supporting the combination. *In re Geiger*, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987). Prior art references taken in combination do not make an invention obvious unless something in the particular prior art references would suggest the advantages to be derived from combining the teachings of the references. *In re Sernaker*, 217 U.S.P.Q. 1, 6 (Fed. Cir. 1983). The mere fact that the prior art could be modified in the manner proposed by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification. *Ex parte Dussaud*, 7 U.S.P.Q.2d 1818, 1820 (PTO Bd.P.App.&Int. 1988). As the Court of Appeals for the Federal Circuit points out, it is impermissible to use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *Fine*, 5 U.S.P.Q.2d at 1600. "Something in the prior art *as a whole* must suggest the desirability, and thus the obviousness of [the invention]." *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 5 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988) (emphasis added). See M.P.E.P. § 2143.

Tsuchida et al., Worley, and Meilhon are not properly combinable under 35 U.S.C. § 103(a) to render the present invention obvious. Tsuchida et al. discloses a package for batteries having a single heat-shrinkable film. Worley discloses a battery package having a plurality of individual packs of batteries packaged together in a heat-shrunk film. Meilhon teaches lines of perforations in a film to facilitate the opening of a pack of articles. There is no objective teaching in Tsuchida et al., Worley, or Meilhon, nor is there knowledge generally available to one of ordinary skill in the art, that would lead the artisan to combine the second heat-shrinkable film of the battery package disclosed in Worley and the lines of perforations in the heat-shrinkable film of the pack disclosed in Meilhon as part of the battery package as taught by Tsuchida et al. to achieve a second heat-shrinkable film and at least one pore therein in a modified Tsuchida et al. device. Accordingly, the Tsuchida et al., Worley, and Meilhon

references are not properly combinable under 35 U.S.C. § 103 to render the present invention obvious.

One of ordinary skill in the art following the teachings of Tsuchida et al., Worley, and Meilhon would not create a battery package as recited in claims 17-19. Tsuchida et al. and Meilhon teach perforations in the wrap layer closest to the packaged articles. Although Worley teaches a battery package having two heat-shrinkable films, it does not teach putting pores in the second heat-shrinkable film between unit packages. The state of the art only teaches perforations in the layer of film which contacts the packaged articles. That is, the cited prior art only teaches perforations in a first heat-shrunk film and does not teach pores in a second heat-shrinkable film. Without an objective teaching of perforations in a second layer of shrink wrap, the Examiner has not met his burden of establishing a *prima facie* case of obviousness and, therefore, the rejection is improper.

For the aforementioned reasons, claim 17 and claims 18 and 19 dependent therefrom are patentably distinct over Tsuchida et al. in view of Worley and Meilhon. Accordingly, Applicants respectfully request that the rejection of claims 17-19 be withdrawn.

#### **Allowable Subject Matter**

The Examiner indicated that claim 8 would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. As previously discussed, Applicants have rewritten claim 7 to include all of the limitations of claim 8. Additionally, the Examiner stated that claim 9 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112, second paragraph. As previously discussed, Applicants have amended claim 7 from which claim 9 depends to include the limitations of claim 8 and establish proper antecedent basis for the elements in claim 9. Accordingly, Applicants respectfully submit that claims 7 and 9, and claims 10-15 which depend from claim 7, are in condition for allowance.

**CONCLUSION**

In view of the foregoing Amendment and Remarks, Applicants respectfully submit that the present Application, including claims 7, 9-15, and 17-19, as amended, is in condition for allowance and such action is respectfully requested.

Respectfully submitted,

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